

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Parts 1, 3, 5, and 10

[Docket No.: 980826226-0202-03]

RIN 0651-AA98

Changes To Implement the Patent Business Goals

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) has established business goals for the organizations reporting to the Commissioner for Patents (Patent Business Goals). The focus of the Patent Business Goals is to increase the level of service to the public by raising the efficiency and effectiveness of the Office's business processes. In furtherance of the Patent Business Goals, the Office is changing the rules of practice to eliminate unnecessary formal requirements, streamline the patent application process, and simplify and clarify the provisions of the rules of practice.

DATES: Effective Dates: This rule is effective November 7, 2000, except that the changes to §§ 1.27, 1.78, 1.131, 1.132, 1.137, 1.152, 1.155, 1.324, 1.366, 1.740, and 1.760, and the removal of § 1.44 are effective September 8, 2000.

Applicability Dates: Computer program listings in compliance with former § 1.96 will be accepted until March 1, 2001. After that date, computer program listings must comply with revised § 1.96. Amendments in compliance with former § 1.121 will be accepted until March 1, 2001. After that date, amendments must comply with revised § 1.121.

The new two-year limit for requesting refunds under § 1.26 will be applied to any fee paid regardless of when it was paid. For previously paid fees, the two-year time period for requesting a refund will expire on the later of November 7, 2000 or the date that is two years from the date the fee was paid.

FOR FURTHER INFORMATION CONTACT: Hiram H. Bernstein ((703) 305-8713) or Robert W. Bahr ((703) 308-6906), Senior Legal Advisors, or Robert J. Spar, Director ((703) 308-5107), Office of Patent Legal Administration (OPLA), directly by phone, or by facsimile to (703) 305-1013, marked to the attention of Mr. Bernstein, or by mail addressed to: Box Comments—Patents,

Commissioner for Patents, Washington, D.C. 20231.

Additionally, the following members of OPLA may be called directly for the matters indicated:

Robert Bahr ((703) 308-6906): §§ 1.22, 1.25, 1.26, 1.53, 1.55, 1.72, 1.76, 1.78, 1.112, 1.131, 1.132, 1.137, 1.138, 1.193, 1.311 through 1.313, 1.366, Part 5, and Part 10.

Hiram Bernstein ((703) 305-8713): §§ 1.9, 1.22, 1.26 through 1.28, 1.41, 1.48, 1.56, 1.85(c), 1.97, 1.98, 1.105, 1.111, 1.115, 1.133, 1.136, 1.322 through 1.324, and Part 3.

Robert Clarke ((703) 305-9177): Processing and petition fees, and § 1.52(b)(2).

James Engel ((703) 308-5106): §§ 1.152 *et seq.*

Eugenia Jones ((703) 306-5586): §§ 1.9, 1.27, and 1.28.

Jay Lucas ((703) 308-6868) or Anton Fetting ((703) 305-8449): §§ 1.96, and 1.821 *et seq.*

Joe Narcavage ((703) 305-1795): §§ 1.52(b)(6), 1.121, 1.125, and 1.173 *et seq.*

Kenneth Schor ((703) 308-6710): §§ 1.97, 1.98, 1.173 *et seq.*, 1.510 *et seq.*, and Part 3.

Fred Silverberg ((703) 305-8986): § 1.63 (oath or declaration) form.

Karin Tyson ((703) 306-3159): §§ 1.14, 1.33, 1.44, 1.47, 1.51, 1.52 (except (b)(2) and (b)(6)), 1.59, 1.63, 1.64, 1.67, 1.77, 1.84, 1.85 (except (c)), 1.163, and 1.720 *et seq.*

SUPPLEMENTARY INFORMATION: The organizations reporting to the Commissioner for Patents have established five business goals (Patent Business Goals) to meet the Office's Year 2000 commitments. The Patent Business Goals have been adopted as part of the Fiscal Year 1999 Corporate Plan Submission to the President. The five Patent Business Goals are:

Goal 1: Reduce Office processing time (cycle time) to twelve months or less for all inventions.

Goal 2: Establish fully-supported and integrated Industry Sectors.

Goal 3: Receive applications and publish patents electronically.

Goal 4: Exceed our customers' quality expectations, through the competencies and empowerment of our employees.

Goal 5: Align fees commensurate with resource utilization and customer efficiency.

This final rule makes changes to the regulations to support the Patent Business Goals. A properly reengineered or reinvented system eliminates the redundant or unnecessary steps that slow down processing and frustrate customers. In furtherance of the Patent

Business Goals, these changes to the rules of practice take a fresh view of the business end of issuing patents, and continue a process of simplification. Formal requirements of rules that are no longer useful are eliminated. Once the intent of an applicant is understood, the Office will simply go forward with the processing. The essentials are maintained, while formalities are greatly reduced. The object is to focus on the substance of examination and decrease the time that an application for patent is sidelined with unnecessary procedural issues.

In streamlining this process, the Office will be able to issue a patent in a shorter time by eliminating formal requirements that must be performed by the applicant, his or her representatives and the Office itself. Applicants will benefit from a reduced overall cost to them for receiving patent protection and from a faster receipt of their patents.

The Office initially published an advance notice of proposed rulemaking containing twenty-one initiatives. See *Changes to Implement the Patent Business Goals*, Advance Notice of Proposed Rulemaking, 63 FR 53497 (October 5, 1998), 1215 *Off. Gaz. Pat. Office* (October 27, 1998) (Advance Notice). The Office published a notice of proposed rulemaking, proposing a number of changes to the rules of practice to implement the Patent Business Goals that contained about half of the topics set forth in the advance notice plus additional items. See *Changes to Implement the Patent Business Goals*, Notice of Proposed Rulemaking, 64 FR 53771 (October 4, 1999), 1228 *Off. Gaz. Pat. Office* 15 (November 2, 1999). This final rule contains a number of changes to the text of the rules as proposed for comment. The significant changes (as opposed to additional grammatical corrections) are discussed below. Familiarity with the Advance Notice and Notice of Proposed Rulemaking is assumed.

The title "Commissioner of Patents and Trademarks" was changed to "Director of the United States Patent and Trademark Office" by § 4732 of the "American Inventors Protection Act of 1999" (Title IV of the "Intellectual Property and Communications Omnibus Reform Act of 1999") that was incorporated and enacted into law on November 29, 1999, by § 1000(a)(9), Division B, of Public Law 106-113, 113 Stat. 1501 (1999). To avoid inconsistent use of the title "Commissioner" and "Director" in the rules of practice, the Office plans to change the title "Commissioner" wherever it appears in the rules of practice to "Director" in a separate rule change.